REMARKS

Claims 1, 34, 65, and 76 are being amended. No new matter is being added. Reconsideration and further examination are respectfully requested.

§101 Rejections

The Applicant thanks Examiner Lee for the courtesy of an interview on March 23, 2010. The Examiner and Applicant's undersigned representative discussed claim 1, namely the features of "generating a morphing advertisement" and "delivering at one time, from the server to an end user device." Both parties agreed that the interview aided the mutual understanding of the invention.

§101 Rejections

Claims 76-83 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In order to expedite prosecution and without conceding to the rejections, claim 76 has been amended. Applicant respectfully requests the Examiner withdraw the §101 rejections.

§112 Rejections

Claims 34-64 are rejected under 35 U.S.C. § 101 as allegedly being indefinite. In order to expedite prosecution and without conceding to the rejections, claim 34 has been amended. Applicant respectfully requests the Examiner withdraw the §112 rejections.

§103 Rejections

Claims 1-3, 5-12, 26, 28, 34-43, 56, 58, 60, 65-70, 71, 73-74 and 76-80, 82-83 are rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent Application Publication No. 2003/0146939 (Petropoulos), in view of Official Notice with "System & method for Enabling Multi-Element Bidding for Influencing a Position on a Search Result List Generated by a Computer Network Search Engine" (Meisel) or "Online Media Exchange" (Patel) as support. Claim 33, 64, and 75 are rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Petropoulos in view of Official Notice. Claims 27, 57, 72 and 81 were

rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos as applied to claims 26, 56, 71, or 76 in view of U.S. Patent Application Publication No. 2003/0224340 (Housman). Claims 13-24 and 44-55 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos as applied to claims 1 or 34, and further in view of U.S. Patent No. 7,035,812 (Meisel). Claims 29-32 and 61-63 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of Meisel, and further in view of U.S. Patent Application Publication No. 2003/0135460 (Telagon). Applicant respectfully traverses these rejections.

Claim 1 recites a method comprising "generating, at a server, a morphing advertisement including a compact display format including an associated expansion icon, an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, and code a client device uses to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format; receiving a request for one or more advertisements related to a subject matter of interest to be presented with content associated with a publisher; and delivering at one time, from the server to an end user device, the morphing advertisement in response to the request to be presented with the content associated with the publisher, the morphing advertisement including the compact display format, the expanded display format, and the code."

Applicant respectfully asserts that the relied upon portions of Petropoulos do not describe "generating, at a server, **a morphing advertisement including a compact display format** including an associated expansion icon, **an expanded display format** comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option**, and code** a client device uses to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format," as recited in claim 1.

The Examiner agrees that Petropoulos does not explicitly disclose these claim features and states:

PETROPOULOS does not disclose explicitly generation at the server of the ad including format 1, format 2 and code or instructions allowing transition between the two formats, as claimed.

However it would have been obvious to one having ordinary skill in the art at the time of the invention (herein a "PHOSITA") that such advertisement would have to be generated before it can be sent to end user devices and to display as disclosed in PETROPOULOS.

As stated earlier during prosecution, an ad with code or instructions is only a set of files. PETROPOULOS discloses at Fig 6, and [0064] a network of servers and other appliances connected to the end users by networks including the internet.

(Also as stated earlier , PETROPOULOS is interpreted as disclosing storing a plurality of advertisements associated with one or more subject matters of interest to users, the plurality of advertisements comprising at least one morphing advertisement (Fig 1, items 60, 53, 54 are morphing ads in a search result lists; Fig 7, item 753: data store; [0073]: search results made of documents or webpages relevant to a subject searched are interpreted to include advertisements which are stored in data store 753) thus generation of the ad before storing, is obvious).

Thus it would have been obvious that the ad files as disclosed by PETROPOULOS above would have to be generated at some server to be sent to PETROPOULOS 's end user.

Further, if generation were to be interpreted as generation by an advertiser using an advertiser interface to input data relevant to the ad, Official Notice is taken that advertiser interfaces enabling advertisers to input and/or modify/edit various advertisement data used for publication on publishers webpages are old and well-known at the time of the invention. **For example, see Meisel 7035812 (see abstract; Figs 2, 9 and associated text); Patel US US-2004/0103024 (see abstract, Figures 21, 22 and associated text; also see Figures 3, 17, 18).**

Thus it would have been obvious to a PHOSITA to add the advertiser interfaces as well known and used in the prior art (e.g. Meisel, Patel) to PETROPOULOS and modify them accordingly to allow the PETROPOULOS 's advertisers to input all necessary data to render the ad with the compact and expanded formats using the codes and instructions as disclosed in PETROPOULOS. In view of the level of skill evidenced in at least the above cited references a PHOSITA would have known to modify the advertiser interfaces accordingly.

Applicant respectfully disagrees.

The relied upon portions of Petropoulos provide:

[0073] At a very high conceptual level, this is explained with reference to FIG. 7, wherein a query or search 751 is submitted to an algorithm 752 for searching a large data store 753. The algorithm 751 and/or the data store 753 may contain information about millions of documents and web pages but also about common queries and relevance factoring. A combination of the algorithm 751 and the data store 753 generate a results page 754, which generally lists documents or web pages that relate to the query in the order of their perceived relevance. The invention contemplates that the user's use of preview information is monitored while the user evaluates the results page.

The relied upon portions merely describe that the data store contains information about documents and web pages. The search result page (nor any individual search result entry) displayed in the Petropoulos system does not include <u>all three</u> of "a compact display format, an expanded display format, and code a client device uses to transition the morphing advertisement from the compact display format into the expanded display format," as recited in claim 1. Applicant respectfully asserts that the relied upon portions also fail to teach or suggest generating such a morphing advertisement which includes <u>all three</u> of "a compact display format, an expanded display format, and code a client device uses to transition the morphing advertisement from the compact display format into the expanded display format," as recited in claim 1.

Applicant respectfully asserts that the asserted obviousness rejection is improper at least because the Examiner has not demonstrated how the relied upon references "expressly or impliedly suggest the claimed invention," and Examiner has not "present[ed] a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP § 706.02(k).

For example, the Examiner fails to demonstrate that the relied upon portion of Petropoulos describes or suggests "generating, at a server, a morphing advertisement including a compact display format including an associated expansion icon, an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, and code." The Examiner also fails to provide any line of reasoning as to why the "generating" element of claim 1 would be obvious in view of the relied upon art except merely stating that it would be.

Finally, the Examiner has stated that "if generation were to be interpreted as generation by an advertiser using an advertiser interface to input data relevant to the ad, Official Notice is taken that the advertiser interfaces enabling advertisers to input and/or modify/edit various advertisement data used for publication on publishers webpage." However, the Official Notice taken does not correspond to Applicant's claimed limitation which requires a morphing advertisement is generated which includes all three of "a compact display format, an expanded display format, and code a client device uses to transition the morphing advertisement from the compact display format into the expanded display format," as recited in claim 1.

Applicant also respectfully asserts that the relied upon portion of Petropoulos does not describe "**delivering at one time**, from the server to an end user device, the morphing advertisement in response to the request to be presented with content associated with the publisher, **the morphing advertisement including the compact display format, the expanded display format, and the code**," as recited in claim 1.

The Examiner in rejecting the claims suggests:

> An advertisement is a file or set of files. In PETROPOULOS , the advertisement is considered a file or set of files, comprising the totality of data about format 1 (search result), data about format 2 (preview window), including their contents, and functionalities such as the expansion icon and code such as **the *JavaScript in* PETROPOULOS** 's [0023] *"The defined areas are program-designated (perhaps with JavaScript) areas on results page 59"* which enables the transition from format 1 to format 2. All this data, instructions and code are inherently sent from a server to end user to allow display as disclosed in PETROPOULOS

> (As discussed in last Office Action since the PETROPOULOS's preview window gives details about the search result, and both concern the same subject matter, both are interpreted as concerning, and thus as being, part of the same advertisement. The search result is interpreted as the compact format of the advertisement while the preview is interpreted as the expanded format of the same advertisement).

> (As discussed in last Office Action, format 2 "embedded preview window" suggests some data about the preview window was delivered with the publishers webpage. Since the publishers webpage was delivered with the search result (1st format) and data re. the instructions as well as re. the 2nd format are also on the publishers webpage, thus all 3 components of the ad are delivered together).

Applicant respectfully disagrees. The MPEP provides:

> A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v/ Union Oil Co. of California, 814, F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).[1] To establish <u>inherency</u>, the extrinsic evidence 'must make clear that the missing descriptive matter is <u>necessarily present</u> in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.[2]

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[1] *See* MPEP Section 2131.
[2] *See* MPEP Section 2112, IV.

In the present rejections, no rationale or evidence has been provided that tends to show including a code with the preview window and the search result is an inherent characteristic of Petropoulos. Applicant respectfully asserts that Petropoulos teaches away from the idea providing "The search system returns a results page having JavaScript and DHTML technology . . . The page may include gifs, HTML, DHTML, JavaScript, Flash and other browser cognizable content." See [0054]. Applicant respectfully asserts that Petropoulos's code is already included in the web page and not included as part of any morphing advertisement that is received as recited in claim 1.

Furthermore, the relied upon portions of Petropoulos indicate that a search result is delivered *then* a preview can be prompted. Even if this is construed as being equivalent to Applicant's claimed two display formats, which point the Applicant does not concede, there is not teaching or suggestion in the relied upon portions that two display formats of an advertisement are delivered as part of **a single morphing advertisement** (i.e., delivered at one time, not the result of two separate calls). Applicant respectfully asserts that the relied upon portions do not teach or suggest that the two display formats are delivered as part of a single morphing advertisement and include the code that is used to transition between the two. Rather, as describe in the relied upon portions of the reference, the two different elements are delivered sequentially at two different times (i.e., at a first time the search result is delivered, then at a second time after the user has selected a particular result a preview is delivered). For at least these reasons, Applicant respectfully asserts that the relied upon portions of Petropoulos do not teach or suggest Applicant's claimed morphing advertisement including the compact and expanded display formats as well as the code that allows the end user system to transition between the two.

The relied upon portions of Housman, Meisel, and Telegon also do not teach or suggest the claimed subject matter missing from Petropoulos namely "generating, at a server, a morphing advertisement including a compact display format including an associated expansion icon, an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, and code a client device uses to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format; and

delivering at one time, from the server to an end user device, the morphing advertisement in response to the request to be presented with content associated with the publisher, the morphing advertisement including the compact display format, the expanded display format, and the code."

Accordingly, the relied upon portions of Petropoulos, Housman, Meisel, and Telegon taken alone or in combination, do not teach or suggest each and every element of claim 1, and therefore, cannot support a rejection of this claim under 35 U.S.C. § 103(a). Reconsideration and withdrawal of the rejection is respectfully requested and deemed appropriate for at least these reasons. Claims 2-3, 4-24, 26-33 depend from claim 1 and are allowable for at least the same reasons set forth above with respect to claim 1.

Claim 34 recites "generating a morphing advertisement including a compact display format including an associated expansion icon, an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, and code a client device uses to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format; receiving a request for one or more advertisements related to a subject matter of interest to be presented with contetn associated with a publisher; and delivering at one time the morphing advertisement in response to the request to be presented with the content associated with the publisher, the morphing advertisement including the compact display format, the expanded display format, and the code." Claim 34 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 35-58 and 60-64 depend from claim 34 and are allowable for at least the same reasons set forth above with respect to claim 34.

Claim 65 recites "generating at a server, a morphing advertisement including a compact display format including an associated expansion icon, an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, and a code that the end user system uses to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format; including the morphing advertisement in an electronic document, the morphing advertisement including the compact display format, the expanded display format, the code, and instructions for initially displaying the morphing

advertisement in the electronic document in the compact display format; and delivering at one time, from the server to the end user device, the electronic document including the morphing advertisement." Claim 34 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 66-75 depend from claim 65 and are allowable for at least the same reasons set forth above with respect to claim 65.

Claim 76 recites "generate at a server, a morphing advertisement including a compact display format including an associated expansion icon, an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, and a code an end user system uses to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format; include the morphing advertisement in an electronic document, the morphing advertisement including the compact display format, the expanded display format, the code, and instructions for initially displaying the electronic document in the compact display format; and deliver at one time, from the server to the end user device, the electronic document including the morphing advertisement, wherein the generating, including, and delivering are performed by one or more computers." Claim 76 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 77-83 depend from claim 76 and are allowable for at least the same reasons set forth above with respect to claim 76.

Conclusion

For the foregoing reasons, Applicant submits that all the claims are in condition for allowance. By responding in the foregoing remarks only to particular positions taken by the Examiner, Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, Applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, Applicant's decision to amend or cancel any claim should not be understood as implying that Applicant agrees with any position taken by the Examiner with respect to that claim or other claims.

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Respectfully submitted,

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